

### **REMARKS**

Applicants are submitting this response to contest the Examiner's refusal to enter a submitted Affidavit for consideration. The Examiner alleges the data in the affidavit is not commensurate in scope with the scope of the claims because the submitted data falling within the claims of the present invention only includes 50:50 blends of ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole and C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride. Further, the Examiner says examples illustrative rust inhibitor systems containing the second rust inhibitors (ii) or (iii) were not included in the affidavit, and it has not been established that the unexpected result of the claimed rust inhibitor system comprising the second rust inhibitor (iv) is achievable when mixed in ratios not 50:50 such as 95:5 or 25:75.

The relevant rule of law for the issues presented here is contained in **In re Tiffin**. "Objective evidence or non-obviousness must be commensurate in scope with the claims which the evidence is offered to support. **In re Tiffin**, 448 F.2d 791, 171 USPQ 294 (CCPA 1971). In **In re Tiffin**, the claims in question recited "containers" while non-obviousness was established for "cups". The court ruled that the Appellants claims were too broad and that they included subject matter which was prima facie obvious. From the dictum in **In re Tiffin**, it is clear that "commensurate in scope with the claims" is to be determined on a case-by-case basis.

In this specific instance, the submitted affidavit should be entered for consideration based on the facts. Even though the affidavit was submitted after the appeal brief was filed, it should be entered because (1) it overcomes all of the rejections of record and (2) sufficient reasons for not presenting the affidavit earlier, before the appeal brief was filed, have been provided.

The affidavit submitted by the Applicants includes data that shows a 50:50 blend of a rust inhibitor comprising ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole and C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride produces

a surprising result since the rust performance exhibited by the combination is superior to that which can be exhibited by either of the mentioned rust inhibitors individually. Because the Applicant is only claiming a limited number of rust inhibitor systems (three (3) to be exact) which exhibit the desired effect, it should not be necessary to provide examples for every possible embodiment of the rust inhibitor system.

Out of only three (3) possible embodiments for the claimed rust inhibitor system- (1) a first rust inhibitor, an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a C<sub>8</sub>-C<sub>22</sub> fatty acid; (2) a first rust inhibitor, an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (iii) a half ester of a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid and a C<sub>2</sub>-C<sub>4</sub> alkylene glycol and (3) **a first rust inhibitor, an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (iv) a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride**, Applicants included explicit data in support of one of them. Surely, one of ordinary skill in the art would come to the conclusion that Applicants have included data which illustrates the surprising performance exhibited by the claimed rust inhibitor system and is "commensurate in scope with the claims" based on the specific facts.

The following describes why the affidavit was not filed earlier, before the appeal brief was filed. Applicants had to secure time and resources within their employer company to run the necessary experiments and collect the data submitted in the affidavit. Unfortunately, due to a finite amount of resources within the company, Applicants were not able to obtain the appropriate resources to conduct the experiments until after the deadline for filing the appeal brief. Applicants ran the experiments, collected the data, summarized the data in an affidavit and submitted the affidavit as soon as they could.

For the reasons presented above, the affidavit submitted after the appeal brief was filed should be entered. The affidavit overcomes all of the rejections of record and

sufficient reasons have been provided for not presenting the affidavit earlier, before the appeal brief was filed. Applicants respectfully request the affidavit be entered for consideration.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jacob M. Levine". The signature is fluid and cursive, with the first name "Jacob" being the most prominent.

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